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2 The opinion in support of the decision being entered today was not written
3 for publication and is not binding precedent of the Board.
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6 **UNITED STATES PATENT AND TRADEMARK OFFICE**
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8
9 **BEFORE THE BOARD OF PATENT APPEALS AND**
10 **INTERFERENCES**
11

12
13 Ex parte TENLEY ANNE CARP,
14 MILTON B. FRIEDMAN and
15 NATALYA B. DAVIDOV
16

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18 Appeal 2007-0768
19 Application 10/430,883¹
20 Technology Center 3600
21

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23 Decided: March 22, 2007
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26 Before HUBERT C. LORIN, JENNIFER D. BAHR and LINDA E.
27 HORNER, Administrative Patent Judges.

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29 LORIN, Administrative Patent Judge.

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32 DECISION ON APPEAL
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¹ Filed 7 May 2003. The real party in interest is JurySignUp.com.

1 STATEMENT OF THE CASE

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3 The appeal is from a decision of the Examiner rejecting claims 1, 4-7,
4 11-19 over the prior art. 35 U.S.C. § 134 (2002). We have jurisdiction
5 under 35 U.S.C. § 6 (b) (2002).

6 We AFFIRM.

7 Appellants, in the Brief², argue the claims as a group with respect to
8 each ground of rejection. Pursuant to the rules, the Board selects
9 representative claims 1, 11 and 14 to decide the appeal with respect to each
10 ground of rejection, respectively. 37 CFR § 41.37(c)(1)(vii) (2005).

11 Claims 1, 11 and 14 read as follows:

- 12 1. A method for determining a trial type for which a proposed
13 juror is suitable, comprising:
- 14 a. forming a master database of names of citizens eligible to
15 serve as jurors from a set of all citizens residing within a trial court's
16 jurisdiction;
 - 17 b. forming a master jury wheel from the master database by
18 using a random selection procedure to select a smaller set of names of
19 citizens, said smaller set of names of citizens representative of a fair
20 demographic cross section of the set of all citizens residing within the
21 trial court's jurisdiction;
 - 22 c. randomly selecting a plurality of prospective jurors from the
23 plurality of names of citizens from the master jury wheel and storing
24 data in a database for a jury voir dire system comprising a name, a
25 social security number, a first juror identification number and a court
26 identification number for each one of the plurality of prospective
27 jurors;

² Our decision will make reference to Appellants' Appeal Brief ("Br.," filed 6 June 2006) and to the Examiner's Answer ("Answer," mailed 29 August 2006) and to Appellants' Reply Brief ("Reply," filed 30 October 2006).

1 d. providing access to a Juror Suitability Test form to each of
2 said plurality of prospective jurors over a general purpose computer
3 network, said Juror Suitability Test form including a plurality of
4 questions designed to determine at least one of a plurality of trial
5 types for which each of said prospective jurors is suitable to sit as a
6 juror;

7 e. accepting responses to each of said plurality of questions on
8 the Juror Suitability Test form over said general purpose computer
9 network; and

10 f. comparing the responses for each of said plurality of
11 questions on said Juror suitability Test form to a stored standard set of
12 responses for each of said plurality of questions and assigning a group
13 category to each of said plurality of prospective jurors, said assigned
14 group category indicative of at least one of a plurality of trial types for
15 which each of said plurality of prospective jurors is suitable to sit as a
16 juror.

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18 11. An automated process for conducting jury voir dire for a trial
19 court comprising the steps of:

20 a. transmitting a Juror Suitability Test form to each of a
21 plurality of prospective jurors from a host server over a general
22 purpose computer network, said Juror Suitability Test form including
23 a plurality of questions designed to determine at least one of a
24 plurality of trial types for which each of said plurality of prospective
25 jurors is not suitable to sit as a juror; and

26 b. accepting responses to each of said plurality of questions to
27 said host server over said general purpose computer network to allow
28 comparison of the responses for each of said plurality of questions on
29 said Juror Suitability Test form to a stored standard set of responses
30 for each of said plurality of questions and to allow assignment of a
31 group category to each of said plurality of prospective jurors, said
32 assigned group category indicative of at least one of a plurality of trial
33 types for which each of said plurality of prospective jurors is not
34 suitable to sit as a juror.

35
36 14. The automated process for conducting jury voir dire for a trial
37 court of claim 11, further comprising transmitting a summons for jury
38 service to each one of said plurality of prospective jurors that is

1 suitable, said summons including an assigned report date for said
2 qualified prospective juror to report to the trial court for jury service.

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ISSUES

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Appellants contend that the Examiner has not shown that the

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following claimed limitations are taught or suggested in the cited prior art:

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with respect to claim 1:

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• categorizing responses to a Juror Suitability Test form from
10 prospective jurors and assigning them to a group indicative of a trial type for
11 which a prospective juror is suitable to sit as a juror (see FF 11 below); and,

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• administering the claimed Juror Suitability Test prior to any
13 prospective juror panel being assembled at a trial (FF 12);

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with respect to claim 11:

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• administering the claimed Juror Suitability Test prior to any
17 prospective juror panel being assembled at a trial prior to a prospective juror
18 being summoned as a panel to court for a trial (FF 18); and,

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19

• automating the process (FF 19); and,

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with respect to claim 14:

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• transmitting a summons only to those jurors who are suitable for the
23 trial, the suitability test having already been administered (FF **Error!**

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Reference source not found.)

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The issue is whether Appellants have established that the references

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do not teach or suggest the claimed limitations and thus shown that the

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Examiner erred in rejecting the claims as being unpatentable over the prior

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art.

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FINDINGS OF FACT

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1 The following findings of fact (FF) are believed to be supported by at
2 least a preponderance of the evidence.

3 1. The claims are drawn to an automated process for conducting jury voir
4 dire for a trial court involving the transmitting of a Juror Suitability
5 Test form to each of a plurality of prospective jurors over a general
6 purpose computer network. The Juror Suitability Test form includes a
7 plurality of questions designed to determine for what trial type(s) each
8 prospective juror is (claim 1) or is not (claim 11) suitable to sit as a
9 juror. A computer readable medium containing computer executable
10 instructions for conducting jury voir dire for a trial court comprising
11 instructions for transmitting the The Juror Suitability Test form is also
12 claimed (claim 15).

13 2. The Jury Research Institute (www.jri-inc.com) is a publication
14 modified on, at the latest, April 22, 1999 (page 2). Appellants do not
15 dispute that The Jury Research Institute (www.jri-inc.com) qualifies as
16 prior art. The Jury Research Institute discloses "The Prospective Juror
17 Questionnaire." Page 6. The Jury Research Institute describes a process
18 involving submitting the "Prospective Juror Questionnaire" to jurors in
19 court before voir dire begins. The answers are reviewed and given a
20 score (see page 9: "Develop a uniform scoring system.") and then the
21 prospective jurors are rated (page 10).

22 3. The Northern District of Texas Jury Plan
23 (www.txnd.uscourts.gov/rules/misc_rules.html) is a publication of a
24 plan to implement the policy of the United States as expressed in
25 section 1861, Title 28 of the U.S. Code. It was adopted and went into

- 1 effect in 1998 (see page 27). Appellants do not dispute that the
2 Northern District of Texas Jury Plan qualifies as prior art.
- 3 4. The Examiner finally rejected claims 1, 4-7, and 15-19 as being
4 unpatentable under 35 U.S.C. § 103(a) over the Northern District of
5 Texas Jury Plan in view of The Jury Research Institute. Answer 4.
- 6 5. The Examiner has made a limitation-by-limitation analysis of the
7 claims, finding that the Northern District of Texas Jury Plan discloses
8 steps a., b., and c. of claim 1. Answer 4-5.
- 9 6. The Examiner finds the differences between the subject matter sought
10 to be patented and the Northern District of Texas Jury Plan are (a) the
11 steps in the claim directed to using a Juror Suitability Test form, i.e.,
12 steps d., e., and f. of claim 1, and (b) automating steps d. and e. over a
13 general purpose network. Answer 5-6.
- 14 7. As to steps d., e., and f. of claim 1, the Examiner finds them discussed
15 in The Jury Research Institute at page 4 (sections 1-2), page 6, page 8
16 (section 1), page 9 (section1) and page 10. Answer 5-6.
- 17 8. The Examiner finds "it would have been obvious to one of ordinary
18 skill in the art at the time of the invention to include the Juror
19 Suitability Test of the Jury Research Institute in the well known jury
20 selection process in order to expedite the jury selection process by
21 allowing a more focused and thus quicker voir dire process." Answer 6.
- 22 9. As to automating steps d. and e. over a general purpose network, the
23 Examiner appears to argue that doing so merely provides automatic
24 means for performing the manual activity necessary to conduct the
25 prior art jury plan and that this difference (automatic v. manual) cannot

1 patentably distinguish the claimed process from the prior art-disclosed
2 process because it accomplishes the same result, i.e., jury selection,
3 relying on *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA
4 1958). Answer 6-7.

5 10. The Examiner finds "it would have been obvious to one of ordinary
6 skill in the art at the time of the invention to automate the providing
7 and accepting steps because this would speed up the process of
8 providing and receiving questionnaires, which is a purely known and
9 an expected result of automating a known manual process in the art."
10 Answer 7.

11 11. Appellants argue that the references do not teach categorizing
12 responses to a Juror Suitability Test form from prospective jurors and
13 assigning them to a group indicative of a trial type for which a
14 prospective juror is suitable to sit as a juror.

15 The novel features of the present invention in which prospective
16 jurors respond to a Juror Suitability Test and the responses are
17 categorized and assigned to a group indicative of at least one of a
18 plurality of trial types for which each of the plurality of prospective
19 jurors is suitable to sit as a juror is absent from the references, taken
20 either singly or in combination.

21

22 Br. 15.

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24 12. Appellants also argue that, in contrast to the applied prior art, "the
25 claimed Juror Suitability Test is administered prior to any prospective
26 juror panel being assembled at a trial." Br. 14 (emphasis in original).

27 13. The examiner finally rejected claims 11-13 as being unpatentable
28 under 35 U.S.C. § 103(a) over The Jury Research Institute. Answer 10.

- 1 14. The Examiner has made a limitation-by-limitation analysis of the
2 claims, finding that The Jury Research Institute discloses steps a. and
3 b. of claim 11. Answer 10-11.
- 4 15. The Examiner finds the difference between the subject matter sought to
5 be patented and The Jury Research Institute is in automating steps a.
6 and b. using a host server over a general purpose network. Answer 11.
- 7 16. As to automating steps a. and b. using a host server over a general
8 purpose network, the Examiner appears to argue that doing so merely
9 provides automatic means for performing the manual activity
10 necessary to conduct the prior art jury plan and that this difference
11 (automatic v. manual) cannot patentably distinguish the claimed
12 process from the prior art-disclosed process because it accomplishes
13 the same result, i.e., jury selection, relying on *In re Venner*, 262 F.2d
14 91, 95, 120 USPQ 193, 194 (CCPA 1958). Answer 11-12.
- 15 17. The Examiner finds "it would have been obvious to one of ordinary
16 skill in the art at the time of the invention to automate the providing
17 and accepting steps because this would speed up the process of
18 providing and receiving questionnaires, which is a purely known and
19 an expected result of automating a known manual process in the art.
20 The Jury Research Institute discusses the want to expedite the jury
21 selection process by allowing a more focused and thus quicker voir
22 dire process. See page 6, section 2." Answer 12.
- 23 18. Appellants argue that "the Juror Suitability Test of the claimed
24 invention is administered prior to a prospective juror being summoned
25 as a panel to court for a trial." Br. 16 (emphasis in original).

- 1 19. Appellants also argue that "automation of the process is not disclosed
2 in the applied references." Br. 16.
- 3 20. The examiner finally rejected claim 14 as being unpatentable under 35
4 U.S.C. § 103(a) as being unpatentable over The Jury Research Institute
5 in view of the Northern District of Texas Jury Plan. Answer 13.
- 6 21. Claim 14 depends on claim 11.
- 7 22. To address the features of claim 14, the Examiner cites the Northern
8 District of Texas Jury Plan, finding that it "teaches transmitting a
9 summons for jury service to each one of said plurality of prospective
10 jurors that is suitable, said summons including an assigned report date
11 for said qualified prospective juror to report to the trial court for jury
12 service," citing page 17. Answer 13.
- 13 23. Appellants do not discuss the Northern District of Texas Jury Plan and
14 therefore do not dispute the Examiner's finding of FF 22.
- 15 24. Appellants' complete argument is:
- 16 It is respectfully submitted that the Examiner has
17 mischaracterized the content of claim 14. In particular, the Examiner
18 characterizes the claim as summoning the juror before performing
19 the suitability test, and therefore asserts that *The Jury Research*
20 *Institute* discloses this feature.
- 21 To the contrary, claim 14, as depending from claim 11,
22 transmits a summons only to those jurors who are suitable for the
23 trial, the suitability test having already been administered.
- 24 Accordingly, Appellants respectfully request that the Honorable
25 Board of Appeals and Interferences Reverse the rejection of claim
26 14 under 35 US.C. [sic U.S.C.] § 103.

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28 Br. 16-17.
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1 25. Appellants do not dispute that, if the Examiner's characterization of
2 claim 14 is correct, the prior art discloses the features of claim 14.

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4 PRINCIPLES OF LAW

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6 1. A *prima facie* case of obviousness is established by presenting
7 evidence that would have led one of ordinary skill in the art to combine the
8 relevant teachings of the references to arrive at the claimed invention. See In
9 re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988) and In
10 re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

11 2. "The *prima facie* case is a procedural tool of patent examination,
12 allocating the burdens of going forward as between examiner and applicant.
13 In re Spada, 911 F.2d 705, 707 n.3, 15 USPQ2d 1655, 1657 n.3 (Fed. Cir.
14 1990). The term "*prima facie* case" refers only to the initial examination
15 step. In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir.
16 1984); In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA
17 1976). As discussed in In re Piasecki, the examiner bears the initial burden,
18 on review of the prior art or on any other ground, of presenting a *prima facie*
19 case of unpatentability. If that burden is met, the burden of coming forward
20 with evidence or argument shifts to the applicant." In re Oetiker, 977 F.2d
21 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

22
23 2. Claims are given the broadest reasonable construction consistent with
24 the specification. In re Morris, 127 F.3d 1048, 44 USPQ2d 1023 (Fed. Cir.
25 1997).

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1 3. “What the prior art teaches, whether it teaches away from the claimed
2 invention, and whether it motivates a combination of teachings from
3 different references are questions of fact.” *In re Fulton*, 391 F.3d 1195,
4 1199-1200, 73 USPQ2d 1141, 1144 (Fed. Cir. 2004).

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6 4. “[I]t is well settled that it is not “invention” to broadly provide a
7 mechanical or automatic means to replace manual activity which has
8 accomplished the same result. *In re Rundell*, 18 CCPA 1290, 48 F.2d 958, 9
9 USPQ 220[, 221] [“Appellant argues that his rejected claims rest upon an
10 automatic mechanism. The mere statement that a device is to be operated
11 automatically instead of by hand, without a claim specifying any particular
12 automatic mechanism, is not the statement of an invention. *Marchand v.*
13 *Emken*, 132 U. S. 195; *In re Gill*, 17 C. C. P. A. (Patents) 700, 36 F. (2d)
14 128.”]” *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958).

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17 ANALYSIS

18 The rejection of claims 1, 4-7, 15-19 under 35 U.S.C. § 103(a) over the
19 Northern District of Texas Jury Plan in view of The Jury Research Institute.
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21 The Examiner has presented evidence and a reasoned analysis in
22 support of her contention that one of ordinary skill in the art would have
23 been led to combine the relevant teachings of the references to arrive at the
24 claimed invention and thus established a prima facie case of obviousness of
25 the claimed invention over that of the combined prior art. FF 4-10. The
26 burden now shifts to Appellant to come forward with evidence or argument
27 showing error in the Examiner’s determination.

1 Appellants argue that the references do not teach or suggest
2 categorizing responses to a Juror Suitability Test form from prospective
3 jurors and assigning them to a group indicative of a trial type for which a
4 prospective juror is suitable to sit as a juror. FF 11.

5 Appellants' argument is directed to step f. of the claimed method. In
6 simple terms, step f. describes assigning group categories to prospective
7 jurors (and not the Test's responses, as Appellants have argued), indicative
8 of trial types for which they are suitable to sit as jurors, depending on
9 answers they give to a Juror Suitability Test form. The Juror Suitability Test
10 form is designed to determine whether a prospective juror is suitable for a
11 particular trial type (see step d.). It reads on the "The Prospective Juror
12 Questionnaire" The Jury Research Institute discloses. FF 2.

13 It is clear to one of ordinary skill in the art following the process The
14 Jury Research Institute describes (FF 2) that prospective jurors in the trial
15 may attain a rating that would cause counsel to either exercise or not
16 exercise a peremptory challenge to the juror's suitability as a juror in the
17 trial. In rating prospective jurors based on their responses to the
18 questionnaire, The Jury Research Institute process is in effect categorizing
19 prospective jurors based on their suitability for the trial, that is, whether the
20 prospective juror is suitable for the type of trial for which he or she has been
21 called to serve. While The Jury Research Institute does not explicitly state
22 that the prospective jurors are categorized by groups indicative of a trial type
23 for which a prospective juror is suitable to sit as a juror, that is in effect what
24 The Jury Research process accomplishes. In other words, the scores are in

1 fact group categories indicative of a type of trial for which a prospective
2 juror is suitable to sit as a juror.

3 Appellants also argue that the references do not teach that the claimed
4 Juror Suitability Test is administered prior to any prospective juror panel
5 being assembled at a trial. FF 12. However, this argument is not
6 commensurate in scope with what is claimed. Its acceptance requires us to
7 read into the claims a step of administering the Test to a prospective juror
8 panel prior to being assembled at a trial. However, given their broadest
9 reasonable interpretation consistent with the specification, the claims on
10 appeal require no more than providing the Test to prospective jurors and
11 accepting their responses over a computer network, and that can be
12 accomplished while a prospective juror panel is assembled at a trial. *In re*
13 *Self*, 671 F.2d 1344, 1348, 213 USPQ 1, 5 (CCPA 1982) (“Many of
14 appellant’s arguments fail from the outset because, ... they are not based on
15 limitations appearing in the claims”).

16 All of Appellants' arguments having been addressed and found
17 unpersuasive as to error in the rejection, the rejection is affirmed.

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22 The rejection of claims 11-13 under 35 U.S.C. § 103(a) The Jury Research
23 Institute.

24

25 The Examiner has presented evidence and a reasoned analysis in
26 support of her contention that one of ordinary skill in the art would have

1 been led to the relevant teachings of The Jury Research Institute to arrive at
2 the claimed invention and thus established a prima facie case of obviousness
3 of the claimed invention over that of The Jury Research Institute. FF 13-17.
4 The burden now shifts to Appellant to come forward with evidence or
5 argument showing error in Examiner's determination.

6 Appellants argue that that the references do not teach that the claimed
7 Juror Suitability Test is administered prior to any prospective juror panel
8 being assembled at a trial. FF 18. However, as before, this argument is not
9 commensurate in scope with what is claimed. Its acceptance requires us to
10 read into the claims a step of administering the form to a prospective juror
11 panel prior to being assembled at a trial. However, given their broadest
12 reasonable interpretation, the claims on appeal require no more than
13 transmitting the form to prospective jurors and accepting their responses
14 using a host server over a computer network, and that can be accomplished
15 while a prospective juror panel is assembled at a trial.

16 Appellants also argue that "automation of the process is not disclosed
17 in the applied references." FF 19. That is the sum total of Appellants'
18 argument. A mere suggestion that appellants' process does automatically
19 what The Jury Research Institute process does by hand is not *per se* a strong
20 argument as the Examiner has suggested, where no difference in mechanism
21 is shown between conducting a process automatically and doing the same by
22 hand, a patentable distinction has not been made out by arguing that the
23 instant process involves "automation." FF 16. We do not find this argument,
24 without more, overcomes the Examiner's prima facie case of obviousness.

1 All of Appellants' arguments having been addressed and found
2 unpersuasive as to error in the rejection, the rejection is affirmed.

3
4 The rejection of claim 14 under 35 U.S.C. § 103(a) as being unpatentable
5 over The Jury Research Institute in view of the Northern District of Texas
6 Jury Plan.

7
8 Appellants contend that the Examiner's rejection is based on a
9 mischaracterization of claim 14. FF 24. According to Appellants, the
10 Examiner characterized claim 14 as describing a step of transmitting a
11 summons to a juror *before* the suitability test is administered. Appellants
12 argue that claim 14 says otherwise; that is, the summons is transmitted *after*
13 the suitability test is administered.

14 However, claim 14 leaves open the possibility that the summons is
15 transmitted before the suitability test is administered. Claim 14 does not
16 place any limitation on the order in which the steps of transmitting the
17 summons and administering the suitability test are to be performed. Claim
18 14 states: "transmitting a summons for jury service to each one of said
19 plurality of prospective jurors that is suitable," the suitability of the
20 prospective jurors being determined by the suitability test described in claim
21 11. Accordingly, claim 14 simply requires the summons to be administered
22 to jurors determined to be suitable. Claim 14 does not specify when the
23 jurors' suitability must be determined and does not preclude transmitting the
24 summons to jurors determined not to be suitable. Claim 14 encompasses a
25 scenario whereby the summons is transmitted to all prospective jurors *before*
26 determining which of the summoned jurors are suitable to sit on the jury.
27 The result is consistent with what claim 14 recites, i.e., "transmitting a

1 Appellants have not sustained their burden of overcoming the prima
2 facie cases made out by the Examiner.

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DECISION

6 The examiner's rejections of claims 1, 4-7, 11-19 are affirmed.

7 No time period for taking any subsequent action in connection with
8 this appeal may be extended under 37 C.F.R. § 1.136(a). See 37 C.F.R.
9 § 1.136(a)(1)(iv) (2006).

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AFFIRMED

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1 MH2 TECHNOLOGY LAW GROUP
2 1951 KIDWELL DRIVE
3 SUITE 550
4 TYSONS CORNER, VA 22182
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